

U.S. Patent Application No.: 10/733,628
Amendment Dated 8/30/05
Reply to Office Action of June 14, 2005

Amendments to the Drawings

The attached sheet of drawings includes a change to Fig. 7,
and is a Replacement for the original sheet of drawings.

Attachment: Replacement Sheet

REMARKS / ARGUMENTS

Applicant is submitting herewith a replacement sheet of drawings (sheet 5/7) containing Figs. 6 and 7. Numeral 28 appearing in original Fig. 7 has been deleted from the replacement sheet of drawings in accordance with the requirement appearing on page 2 of the Office Action. The enclosed sheet has been marked "Replacement Sheet" in accordance with 37 CFR 184(c).

Entry of the Replacement sheet of drawings is requested.

Paragraph [0018] of the specification has been corrected by the deletion of two of the applications said to be filed concurrently with the captioned subject application. The two deleted application appear to have been filed some time after the captioned application. One of the three applications mentioned was filed shortly before the instant application and has been identified with filing date and serial number. The amended paragraph contains no new matter.

At page 8, Par. 7., of the Official Action, claims 9-10 and 16 were rejected under 35 U.S.C. 102(b) as being anticipated by Kapitza et al (US Pat. 5,781,338). This ground of rejection is traversed as it applies to the claims now presented for re-examination.

Kapitza et al disclose a microscope stage (1) having a base portion (7) with a recess and a ceramic glass plate portion (11) which is disclosed as being transparent for visible light. The upper side of the transparent ceramic glass plate (11) is for placement of specimens. A brightly colored, light scattering surface (12) is located between base portion (7) and the

transparent ceramic glass plate (11). According to Col. 3 of Kapitza et al, for illuminating preparation (6) light that is coupled in is diffusely reflected at the brightly colored, light scattering layer (12) and emerges from the object side of the ceramic glass plate to illuminate the object.

Claims 9-10 reciting "a non-transparent contrasting stage insert", are not anticipated by Kapitza et al, who as pointed out above, require their stage to be fully transparent.

Applicants' specification, as originally filed, is replete with support for --non-transparent--, e.g., page 7, lines 4-5, for example, confirm the invention contemplates a non-transparent contrasting stage insert wherein inserts 28 and 42 may be either solid, hollow, translucent or opaque. Lines 2-3 also mention the inserts may also be metals, and so on.

Accordingly, Kapitza et al do not anticipate the subject matter of the rejected claims either under Section 102(b), or suggest as to render obvious under Section 103, of the Act.

Reconsideration and withdrawal of the rejection of claims 9-10 and 16 are courteously requested.

At page 5 of the Official Action, claims 1, 7-8 and 13 were rejected under 35 U.S.C. 103(a) as unpatentable over Kapitza et al in view of Kawasaki (US Pat. 6,040,940). This ground of rejection is courteously traversed as it applies to the claims now presented for further examination.

Applicants' remarks above relative to Kapitza et al are incorporated herein with respect to this ground of rejection for reasons of obviousness. Kawasaki, like Kapitza et al, employ a glass stage (8) or neutral density filter, i.e., filtering

glass, which also allows the transmission of light, in distinction with Applicants' non-transparent contrasting stage insert. In sum, Kawasaki fails to off-set the shortcomings of Kapitza et al, previously discussed, to arrive at a *prima facie* case of obviousness, under 35 U.S.C. 103(a).

Reconsideration and withdrawal of the rejection of claims 1,7-8 and 13 over Kapitza et al in view of Kawasaki (US Pat. 6,040,940) are courteously requested.

At par. 10 of the Official Action, claims 2-3 and 14 were rejected under 35 U.S.C. 103(a) over Kapitza et al as applied to claims 1 and 9, and further in view of Brock (US Pat. 5,071,241). This ground of rejection is respectfully traversed.

The rejected claims are intended to include *inter-alia* notches or nubs, for example, to mate with the contrasting stage insert for proper alignment in the recess. This is disclosed in detail at page 6 of the specification and illustrated in Figs. 2-3 of the drawings.

Brock has been cited to support the conclusion that the attachment of support plate 106 which holds a light transmitting tube 102 to the underside of a microscope stage using threaded screws 112 suggests as to render obvious the subject matter of claims 2-3 and 14.

However, Col. 7, lines 5-8 of Brock make clear the threaded screws 112 are for mounting (holding) plate 106 to the underside of stage 22, which contains no recess. Otherwise, the needed optical tube 100 would simply fall off by shear gravity.

By contrast, Applicants' invention includes a recess in the stage for receiving a contrasting stage insert keyed for proper alignment within the recess.

In sum, threaded screws, like those of Brock are neither needed, nor required according to Applicant's invention, for the claims merely recite "alignment means for aligning the insert within said recess." Screws for purposes of "permanently" mounting a component to the stage vis-à-vis Brock, are not required.

Accordingly, the rejection of claims 2-3 and 14 cannot stand because neither Brock, nor Kawasaki off-set the shortcomings of Kapitza et al with respect to the application of a -non-transparent contrasting stage insert--, and for the omission of any teaching of alignment means for aligning a contrasting stage insert into a recess on the topside of a stage, which would not fall by gravity like that of Brock's understage mounted optical tube .

Reconsideration and withdrawal of the rejection of claims 2-3 and 14 are courteously requested.

At par. 11 of the Official Action, claims 4-6, 11-12 and 15 were rejected for reasons of obviousness under 35 U.S.C. 103(a) as unpatentable over Kapitza et al, in view of Kawasaki as applied to claims 1 & 9, and further in view of Zimmermann et al (US Patent Application Publication 2004/0085629). This ground of rejection is courteously traversed.

This ground of rejection cannot stand because the above identified US Patent Application Publication, and the captioned subject application are commonly owned. The US Patent

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Application Publication is assigned to Leica Microsystems (Schweiz) AG, Heerbrugg, Switzerland, and the captioned subject application is Assigned to Leica Microsystems, Inc., Buffalo, NY.

Leica Microsystems (Schweiz) AG and Leica Microsystems, Inc., are both wholly owned subsidiaries of Leica Microsystems AG, Wetzler, Germany. Hence, both the cited patent application and the rejected captioned application are effectively commonly owned.

Under the present circumstances the rule that should apply is cited as: *¶ 7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor* Appearing on Page 700-59 of the MPEP, cited below:

¶ 7.21.01 Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor

"Claim [1] provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. [2] which has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. [4]

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2)." (*Emphasis added*)

STATEMENT OF COMMON OWNERSHIP

The captioned Application (Application SN 10/733,628, filed 12/11/03) and the reference, US Patent Application Publication 2004/0085629 were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Effective November 29, 1999, subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention because the subject matter of the Zimmermann et al publication and the claimed invention were, at the time the invention was made, effectively owned by the same person, namely Leica Microsystems AG, Wetzlar, Germany.

Accordingly, the basis for the rejection of the claims for reasons of obviousness that includes the citation of US Pat. Application Pub. 2004/0085629 cannot stand because this citation has been effectively removed as a reference. However, even if the Zimmermann et al patent publication was not removed as a reference, the rejection still could not stand for reasons outlined above in connection with the shortcomings discussed regarding Kapitza et al.

The rejection at Par. 14 of the Official Action also relies on Zimmermann et al in the rejection of 19-20 for reasons of obviousness under 35 U.S.C. 103(a). For the reasons outlined above in connection with the rejection appearing in Par. 11, Applicants also maintain the rejection of claims 19-20 appearing

in Par. 14, supported by Zimmermann et al, cannot stand for the same reasons set-forth above relative to the common ownership of each.

At Par. 12 of the Official Action, claim 17 was rejected under 35 U.S.C. 103(a) as unpatentable over Kapitza et al in view of Sattler (US Pat. 4,906,083). This ground of rejection is courteously traversed.

The remarks above relative to Kapitza et al are incorporated herein. While gemstones (Sattler) may have a different color than that of the stage insert, the fundamental shortcomings of Kapitza et al with respect to the failure to teach a non-transparent contrasting stage insert are not remedied by the Sattler citation. Sattler teaches specimen holder 54 is formed from translucent Plexiglas for the transmission of light (also See Fig. 3).

Hence, even when Sattler is combined with Kapitza et al the combined teachings fail to make out a *prima facie* case of obviousness.

Accordingly, reconsideration and withdrawal of the rejection of claim 17 are courteously requested.

At Par. 13 of the Official Action, Claim 18 was rejected for reasons of obviousness under 35 U.S.C. 103(a) as unpatentable over Kapitza et al in view of Sattler as applied to the rejection of claim 17, and further in view of Kawasaki. This ground of rejection is traversed as it applies to the claims now presented for further examination.

Sattler discloses at Col. 11, lines 28-30 that arrow 72 indicates the displaceability of the specimen holder 54 in the

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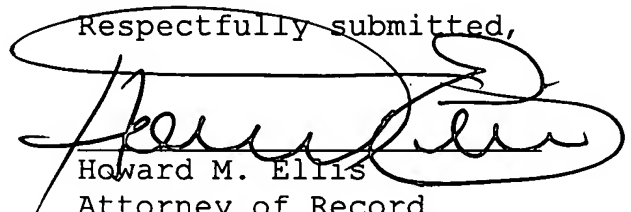
guide of stage 10. Hence, it appears the specimen holder 54 may be releaseably secured. Notwithstanding, the specimen holder of Sattler, including that of Kapitza et al are transparent, unlike applicant's claimed invention. Kawasaki fails to offset the fundamental shortcomings of the rejection relative to a non-transparent contrasting stage insert.

Reconsideration and withdrawal of the rejection of claim 18 are courteously requested.

In summation, the claims have been appropriately amended as to avoid the references cited and applied in rejecting the claims. Applicant has pointed out why the claims are patentable over the applied art and why the at least one reference to Zimmermann et al does not qualify as prior art, as a result of common ownership.

This application should now be in condition for allowance, and notification of the same at an early date is earnestly solicited.

August 30, 2005

Respectfully submitted,

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